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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,668	06/01/2001	Darrel D. Cherry	10008156-1	2901

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HEWLETT-PACKARD COMPANY  
Intellectual Property administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/872,668	<b>Applicant(s)</b> CHERRY ET AL.	
	<b>Examiner</b> Yehdega Retta	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Response to Amendment*

This office action is in response to the Request for Continued Examination (RCE) filed June 9, 2006. Applicant amended claims 1, 9, 10 and 13. Claims 1-14 are still pending.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim recite “obtaining a media request for online version of at least one a print magazine, journal, book, or newspaper” or “obtaining a media request for an online version of a print book”. The specification disclose “a user may obtain a hardcopy of a desired media such as a magazine, newspaper, journal, or the like, and the desired media, including advertisements, may be tailored to the user's preferences”. The specification also teaches “a user desiring to obtain media hardcopy, such as a newspaper, magazine, short story, or otherwise, selects the desired media using a dynamic media selection interface”. The specification however does not teach requesting online version of a print book and creating a customized hardcopy of the print book targeted to the identified particular user.

***Claim Rejections - 35 USC § 102***

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Castle (US2002/0077891).

Regarding claim 1, Castle teaches obtaining a set of user information; obtaining a media request for online version of at least one of a print magazine, journal, book or newspaper; receiving an electronic copy of the media request (see par. 0009, 0010); Castle teaches the Hewlett Packard Instant Delivery service (HPID) using the web to selectively obtain and deliver informational content to recipients; only stories of interest to each subscriber (media on demand); determining a set of advertisement space information from the electronic copy of said media request for at least one advertisement space in the media request (see [0012], [0016], [0017]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored; factor for determining which ads to place in publication ...); communicating said set of advertisement space information to at least one advertising provider to solicit bidding on the advertisement space from the advertisement provider; receiving at least one bid from the advertising provider; comparing the received bids for at least one advertisement space; choosing a winning bid for the space (see par. [0013], [0014], [0017]); querying the advertising provider for an electronic copy of an advertisement for the space and receiving the electronic copy of said advertisement in response to querying the advertising provider for an electronic copy of the advertisement ( see, par. [0017], [0018], [0028], [0029]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored. Castle teaches combining said

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electronic copy of the advertisement with the media request (see par. [0009], [0010]). Castle teaches the HPID uses the web to selectively obtain and deliver informational content to recipients, who subscribe to the HPID service (subscribers) to whom data files, which comprise the publication, are delivered via electronic file transfer. Castle teaches the advertisement of the advertiser offering the highest price is placed in the publication (see par. [0006]). Castle also teaches method to size advertising and content information for publication (see par. [0018], [0031], [0032] ) see also (claims 1-37 for placing of the advertisement in the publication).

Castle teaches on-line publication services collect publications only stories of interest to subscriber (see 0010). Castle teaches the on-line publication sending advertising to subscribers by using subscriber demographic data. Requiring each registered user to log-in and provide identifying information is inherent feature of subscriber's accessing the on-line service.

Subscribers are registered customers. Castle teaches determining advertisement that is targeted to the identified particular user (0014-0017) and creating the customized hardcopy of the at least one of print ... (see par. [0016]). Castle teaches printing device for printing the publication (see fig. 2, (222) and par. [0028], [0006]).

Regarding claims 2-4, Castle teaches prompting user to input a log-in code; retrieving the code; retrieving user profile; prompting user to register with media selection interface; communicating the profile to at least one advertising provider (see [0009], [0010] and [0014] to [0017], which is inherent feature of subscribing to a service).

Regarding claims 5-7, Castle teaches locating an advertisement space in said electronic copy, assigning advertisement space, determining the dimension of the advertisement space

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determining the location of the space and receiving a set of advertisement space information (see par. [0016], [0017], [0021]).

Regarding claim 8, Castle teaches communicating set of user information to said advertising provider at the same the set of advertisement space information is communicated to said advertising provider (see par. [0014] to [0017], [0022] to [0024], [0032]).

Regarding claims 10-12, Castle teaches requiring user to log-in; retrieving the code; retrieving user profile; displaying a list of available media (see [0009], [0010] and [0014] to [0017], which is inherent feature of subscribing to a service); obtaining a media request *for online version of a print newspaper (see [0009], [0010])*; communicating the request to service provider; determining a content provider for (see par. [0009], [0010]); Castle teaches the Hewlett Packard Instant Delivery service (HPID) using the web to selectively obtain and deliver informational content to recipients; only stories of interest to each subscriber (see [0012], [0016], [0017]); determining a set of advertisement space information from the electronic copy of said media request for at least one advertisement space in the media request (see [0012], [0016], [0017]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored; factor for determining which ads to place in publication ...); communicating said set of advertisement space information to at least one advertising provider to solicit bidding on the advertisement space from the advertisement provider; receiving at least one bid from the advertising provider; comparing the received bids for at least one advertisement space; choosing a winning bid for the space (see par. [0013], [0014], [0017]); querying the advertising provider for an electronic copy of an advertisement for the space and receiving the electronic copy of said

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advertisement in response to querying the advertising provider for an electronic copy of the advertisement ( see, par. [0017], [0018], [0028], [0029]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored. Castle teaches combining said electronic copy of the advertisement with the media request (see par. [0009], [0010]). Castle teaches the HPID uses the web to selectively obtain and deliver informational content to recipients, who subscribe to the HPID service (subscribers) to whom data files, which comprise the publication, are delivered via electronic file transfer. Castle teaches the advertisement of the advertiser offering the highest price is placed in the publication (see par. [0006]). Castle also teaches method to size advertising and content information for publication (see par. [0018], [0031], [0032]) see also (claims 1-37 for placing of the advertisement in the publication). Castle teaches on-line publication services collect publications only stories of interest to subscriber (see 0010); creating a customized hardcopy of the print magazine targeted to the identified particular user (see [0009], [0010], [0016]. Castle teaches the on-line publication sending advertising to subscribers by using subscriber demographic data. Requiring each registered user to log-in and provide identifying information is inherent feature of subscriber's accessing the on-line service. Subscribers are registered customers. Castle teaches determining advertisement that is targeted to the identified particular user (0014-0017).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Castle further in view of Official Notice.

Regarding claim 9, Castle teaches requiring user to log-in; retrieving the code; retrieving user profile; displaying a list of available media (see [0009], [0010] and [0014] to [0017], which is inherent feature of subscribing to a service); obtaining a media request for online version of a print magazine (periodicals) (see [0009], [0010]); communicating the request to service provider; determining a content provider for (see par. [0009], [0010]); Castle teaches the Hewlett Packard Instant Delivery service (HPID) using the web to selectively obtain and deliver informational content to recipients; only stories of interest to each subscriber (see [0012], [0016], [0017]); determining a set of advertisement space information from the electronic copy of said media request for at least one advertisement space in the media request (see [0012], [0016], [0017]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored; factor for determining which ads to place in publication ...); communicating said set of advertisement space information to at least one advertising provider to solicit bidding on the advertisement space from the advertisement provider; receiving at least one bid from the advertising provider; comparing the received bids for at least one advertisement space; choosing a winning bid for the space (see par. [0013], [0014], [0017]); querying the advertising provider for an electronic copy of an advertisement for the space and receiving the electronic copy of said advertisement in response to querying the advertising provider for an electronic copy of the



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advertisement ( see, par. [0017], [0018], [0028], [0029]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored. Castle teaches combining said electronic copy of the advertisement with the media request (see par. [0009], [0010]). Castle teaches the HPID uses the web to selectively obtain and deliver informational content to recipients, who subscribe to the HPID service (subscribers) to whom data files, which comprise the publication, are delivered via electronic file transfer. Castle teaches the advertisement of the advertiser offering the highest price is placed in the publication (see par. [0006]). Castle also teaches method to size advertising and content information for publication (see par. [0018], [0031], [0032]) see also (claims 1-37 for placing of the advertisement in the publication). Castle teaches on-line publication services collect publications only stories of interest to subscriber (see 0010). Castle teaches the on-line publication sending advertising to subscribers by using subscriber demographic data. Requiring each registered user to log-in and provide identifying information is inherent feature of subscriber's accessing the on-line service. Subscribers are registered customers. Castle teaches determining advertisement that is targeted to the identified particular user (0014-0017), creating a customized hardcopy of the print magazine (periodical) targeted to the identified particular user (see [0009], [0010], [0016]. Castle does not teach that the subscriber is identified by log-in with a magnetic stripe card. Official notice is taken that is old and well known in the art of security system for user to log-in through insertion of smart or magnetic card and/or entry of an identification data or biometric data. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement such feature in the Castle's system for the intended use of providing control access to different security levels.

Regarding claims 13 and 14, Castle teaches a computer having a central processing unit, a memory, and at least one communications port (fig. 2); at least one advertisement database for storing advertisement data and associated user information; a listing of advertisement, a set of dimensions and set of user preference data (see par [0012] to [0016]); operational program for obtaining a media request for publication, newspaper, etc. for receiving a user information; for querying advertisement database and determining a bid amount (see par. [0012] to [0018]). Castle does not teach obtaining a media request for an online version of a print book. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Castle system to request an online version of a print book and to provide customized book if the user only wishes to receive some part of the a book.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. Castle, as indicated above, teaches the printing of the publication using subscriber's local printer device, same as applicant's invention. It is shown that Castle does not teach magnetic card, however official notice is taken to the teaching of the magnetic card as been well known. Applicant did not challenge the Examiner on taking the Official notice for the well known feature of using magnetic card, therefore, it is considered admitted prior art.


#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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RETTA YEHDEGA  
PRIMARY EXAMINER